

Docket No.: 19226/931 (R-5495)

PATENT

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Applicant(s) : Hangauer et al.

Serial No. : 09/482,585

Cnfrm No. : 7206

Filed : January 13, 2000

For : A NOVEL METHOD FOR DESIGNING  
PROTEIN KINASE INHIBITORS

Examiner:  
T. Prasthofer

Art Unit:  
1627

**RESPONSE TO RESTRICTION REQUIREMENT AND ELECTION OF SPECIES**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

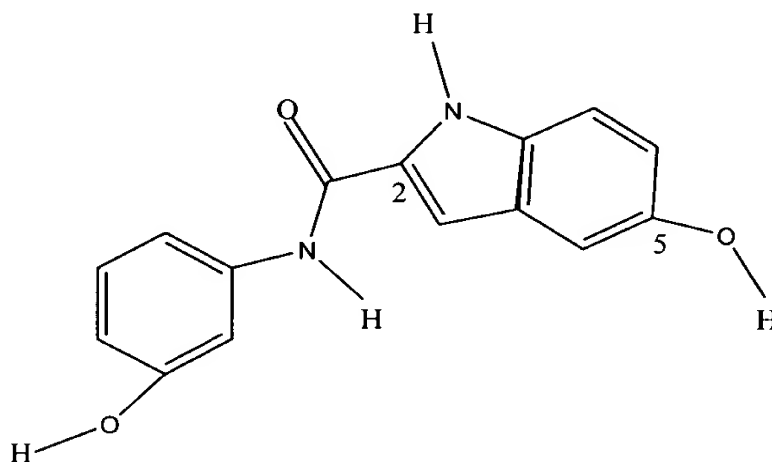
In response to the March 28, 2001, written restriction requirement, applicants hereby elect Group V (i.e., claims 1-20 (in part) and 22), drawn to a method for identifying inhibitors of protein kinases, with traverse. In accordance with page 4 of the written restriction requirement, applicants further elect "wherein the second group consists of indole," with traverse.

However, applicants submit that all groups of invention identified in the outstanding office action are closely related and, therefore, would require common areas of search and consideration. At a minimum, applicants submit that the inventions of Groups VI and VII, which use a product produced by the method of Group V as a starting material, should be examined with Group V. Further, applicants submit that the invention of Group VI should be examined with the claims of Group V, as set forth in the prior oral restriction requirement on October 25, 2000.

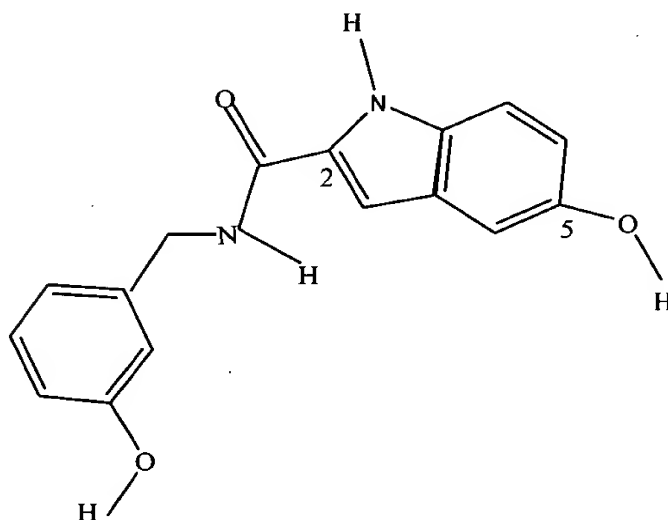
Moreover, to the extent the basis, in part, for the above restriction requirement is to defer examination of certain structures for the second group (or module), such a requirement is and should be an election of species requirement (see MPEP § 803.02, which requires the examiner to impose a provisional election of a single species, and not a restriction requirement, for Markush-type claims including independent and distinct inventions, as in claims 9, 28, and 55 of the present invention). Thus, with regard to the structures for the second group claimed in Groups IV-VII, the proper course in the instant application is to require only an election of species at this time, and not to impose a restriction requirement.

On the basis of the foregoing, applicants respectfully request reconsideration of the outstanding written restriction requirement and submit that the claims of Groups I, II, III, IV, V, VI, and VII should be examined on the merits at this time.

Further, in response to the election of species requirement, applicants hereby elect: (1) Ac-Ile-Tyr-Gly-Glu-Phe-NH<sub>2</sub> as the peptide scaffold; (2) a hydroxyl group as the functional group of claim 3; (3) the following protein kinase inhibitor structure:



and (4) the following modified protein kinase inhibitor structure:



with traverse. Claims reading on the elected species include claims 1-4, 6, 9-20, and 22.

Applicants hereby traverse the election of species requirement on the ground that examination of the presently claimed invention can be conducted without significant burden in the absence of reliance on the above-elected species.

Applicants submit that, at a minimum, the elected subject matter is allowable and, therefore, the claims should be examined to the extent of the presently claimed genus.

Applicants further submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

Date: August 28, 2001

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| I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date below. |                                       |
| <u>Aug. 28, 2001</u><br>Date   | <u>Ruth R. Smith</u><br>Ruth R. Smith |